

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: WALLACH=27A

In re Application of:)	Conf. No.: 3756
)	
David WALLACH et al.)	Art Unit: 1633
)	
Appln. No.: 10/761,370)	Examiner: I. Popa
)	
Filed: January 22, 2004)	Washington, D.C.
)	
For: MODULATORS OF THE FUNCTION)		July 21, 2009
OF RECEPTORS OF THE)	
TNF/NGF RECEPTOR)	

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, Mail Stop AF
401 Dulany Street
Alexandria, VA 22314

Sir:

The Notification of Non-Compliant Appeal Brief issued July 17, 2009, states that the Appeal Brief filed June 19, 2009, was found to be defective for not containing a concise statement of each ground of rejection presented for review and for not presenting an argument under a separate heading for each ground of rejection on appeal.

With respect to the former, the notification states that the Grounds of Rejection section of the brief should include the claims, statutes and references according

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to the rejections stated in the examiner's final rejection and that the section should contain no arguments.

Attached hereto is a new "Grounds of Rejection To Be Reviewed on Appeal" section, in which the first sentence has been modified to insert the numbers of the claims being rejected, rather than merely referring to "all of the claims" and to specify that the rejection is under 35 USC §103(a). At a page and half, the section is reasonably concise. 37 CFR §41.37(c)(1)(vi) states only that the Grounds of Rejection to be Reviewed on Appeal must contain "a concise statement of each ground of rejection presented for review." Applicant's Grounds of Rejection to be Reviewed on Appeal section is reasonably concise and includes each ground of rejection presented for review (in this case, there is only one such ground of rejection).

MPEP 1205.02 gives examples of statements that would comply with the rule but does not state that a longer "concise statement" would be unacceptable. The MPEP does state with respect to this section:

The statement cannot include any argument concerning the merits of the ground of rejection presented for review. Arguments should be included in the "argument" section of the brief.

The concise statement of the ground of rejection appearing in the Grounds of Rejection to be Reviewed on Appeal section of

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the present brief contains no arguments whatsoever concerning the merits of the ground of rejection presented for review. It does not state what is wrong with the rejection. It merely states the full content of the examiner's ground of rejection, including the examiner's stated reasoning. Applicant's arguments only appear in the Argument section of the brief. Accordingly, the attached revised Grounds of Rejection to be Reviewed on Appeal section is full compliance with 37 CFR §41.37(c)(1)(vi). Reconsideration and withdrawal of the objection to this section is therefore respectfully urged.

With respect to the objection to the Arguments section, the notice states that the Arguments section was held to be defective because the rule requires that a separate heading is required for each rejection. Respectfully, it is absurd to hold a brief defective for failure to comply with this part of the rule when there is only a single ground of rejection in the grounds of rejection to be reviewed on appeal section. If there is only one rejection, clearly one cannot have more than one rejection in a single heading. MPEP 1205.03 states that a corrected brief should not be required for minor non-compliance in an appeal brief. Certainly, the absence of a heading in an Argument section identifying the only ground of rejection being appealed is a minor non-

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compliance and the brief may be accepted despite that minor non-compliance in accordance with MPEP 1205.03.

Nevertheless, attached hereto is a new Argument section containing a new main heading that reads "THE REJECTION UNDER 35 USC §103". Thus, the Argument section is now in compliance with the letter of the rule, although it was always in compliance with the spirit of the rule.

The Notification of Non-Compliant Appeal Brief states that a new appeal brief is not required but only the defective sections. The corrected sections are attached hereto.

Reconsideration and withdrawal of the Notification of Non-Compliant Appeal Brief and acceptance of applicant's Appeal Brief as amended is earnestly solicited.

Respectfully submitted,

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2009-07-21RespNon-CompliantAppealBrief.doc